

(Attorney Docket No. 2283)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

(Attorney Docket No. 2283)

In re the Application of:)	
)	
Randy Ulvenes)	
)	
Serial No. 10/694,429)	Group Art Unit 2457
)	
Filed: October 27, 2003)	
)	
Confirmation No. 3346)	Examiner: Michael C. Lai
)	
For: METHOD AND SYSTEM FOR)	
MANAGING PAYMENT FOR)	
WEB CONTENT BASED ON)	
SIZE OF THE WEB CONTENT)	

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Commissioner for Patents
P.O. Box 1450
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APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted pursuant 37 C.F.R. § 41.37, within two months from the October 5, 2009, receipt date of the Notice of Appeal. The Office is authorized to charge the large entity Appeal-Brief fee (\$540.00) to Deposit Account No. 210765 and is generally authorized to charge any underpayment or credit any overpayment in this matter to the same deposit account. Further, the Office is generally authorized to treat any filing in this application that requires an extension of time as incorporating a request for the extension.

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I. Real Party in Interest

The real party in interest is Sprint Spectrum L.P. (a wholly owned subsidiary of Sprint Nextel Corporation), to which this invention is assigned.

II. Related Appeals and Interferences

Appellant is not aware of any related appeals or interferences.

III. Status of Claims

Pending and under appeal are claims 1-6 and 13-25, of which claims 1, 4, 13, 16, and 20 are independent and the remainder are dependent. Claims 7-12 are cancelled. A clean set of the pending claims is attached in the Claims Appendix.

IV. Status of Amendments

No amendments were filed following the final rejection.

V. Summary of Claimed Subject Matter

As noted above, there are five independent claims: claims 1, 4, 13, 16, and 20. These claims relate to providing a user with advanced notice of size-based cost to access particular web content.

Claim 1 recites a method in a communication system in which a request for web content is transmitted over a communication path from a client station to a content server. (*See, e.g.*, specification at page 8, line 4 – page 15, line 20.) According to the method, the following functions are carried out during transmission of the web request within the communication path, between the client station and the content server (*see, e.g.*, specification at page 15, line 24 – page 24, line 19): (i) computing a size-based cost to access the web content (*see, e.g.*, specification at page 30, line 23 – page 35, line 5); (ii) engaging in interstitial communication with the client station to receive user approval to pay the size-based cost (*see, e.g.*, specification

at page 24, line 20 – page 27, line 20; page 30, line 23 – page 37, line 18); and (iii) after receiving the user approval, sending the request along to the content server (*see, e.g.*, specification at page 37, lines 8-12).

Claim 4 recites a method in a communication system in which web content is transmitted over a communication path from a content server to a client station. (*See, e.g.*, specification at page 8, line 4 – page 15, line 20.) According to the method, the following functions are carried out during transmission of the web content within the communication path, between the content server and the client station (*see, e.g.*, specification at page 15, line 24 – page 24, line 19): (i) computing a size-based cost to access the web content (*see, e.g.*, specification at page 30, line 23 – page 35, line 5); (ii) engaging in interstitial communication with the client station to receive user approval to pay the size-based cost (*see, e.g.*, specification at page 24, line 20 – page 27, line 20; page 30, line 23 – page 35, line 23; page 37, line 20 – page 38, line 3); and (iii) after receiving the user approval, sending the web content along to the client station (*see, e.g.*, specification at page 37, lines 26-28).

Claim 13 recites a method in a communication system in which web content is transmitted over a communication path from a content server to a client station (*see, e.g.*, specification at page 8, line 4 – page 15, line 20), where the web content defines a hyperlink to be presented by a browser running on the client station and the hyperlink points to referenced web content (*see, e.g.*, specification at page 30, line 23 – page 35, line 23). The method involves, during transmission of the web content within the communication path, between the content server and the client station, (i) computing a size-based cost to access the web content and (ii) adding an indication of the size-based cost into the web content, in conjunction with the

hyperlink, such that the indication will be presented to a user when the web content is presented to the user (*see, e.g.*, specification at page 30, line 23 – page 35, line 23).

Claim 16 recites a method in a communication system in which web content is transmitted over a communication path from a content server to a client station. (*See, e.g.*, specification at page 8, line 4 – page 15, line 20.) The method comprises, during transmission of the web content within the communication path, the following functions (*see, e.g.*, specification at page 30, line 23 – page 35, line 23): (i) receiving the web content; (ii) detecting a hyperlink within the web content, wherein the hyperlink points to referenced web content (*see, e.g.*, specification at page 31, line 9 – page 34, line 7); (iii) determining a cost of the referenced web content based at least in part on a size of the referenced web content (*see, e.g.*, specification at page 34, lines 8-20); (iv) adding into the web content, in conjunction with the hyperlink, an indication of the determined cost (*see, e.g.*, specification at page 34, lines 15-26); and (v) sending the web content, including the indication, along the access channel to the client station (*see, e.g.*, specification at page 27, line 22 – page 35, line 5), whereby the indication will be presented to a user when the web content is presented to the user, thereby giving the user an advanced notice of the cost of the referenced web content (*see, e.g.*, specification at page 30, line 28 – page 31, line 14).

Claim 20 recites an intermediation system disposed within a web communication path between a client station and a packet-switched network. (*See, e.g.*, specification at page 8, line 14 – page 15, line 20.) According to the claim, the intermediation system comprises (i) a network interface for receiving and sending communications on the HTTP communication path, wherein the network interface receives a communication that carries web content and the web content defines a hyperlink that points to referenced web content (*see, e.g.*, specification at page

19, line 21 – page 24, line 19; page 31, line 9 – page 34, line 7; Figure 10, item 66); (ii) cost-computation logic for computing a size-based cost to access the referenced web content (*see, e.g.*, specification at page 19, line 21 – page 24, line 19; page 34, lines 8-20; Figure 10, item 80); and (iii) cost-embellishment logic for inserting into the web content an indication of the size-based cost to access the referenced web content and for thereby establishing cost-embellished web content (*see, e.g.*, specification at page 19, line 21 – page 24, line 19; page 34, lines 15-26; Figure 10, item 80), wherein the network interface sends the cost-embellished web content along the access channel for ultimate receipt and presentation of the cost-embellished web content by a browser running on the client station (*see, e.g.*, specification at page 27, line 22 – page 35, line 5).

VI. Grounds of Rejection to Be Reviewed on Appeal

- a. Claims 1, 4, and 13 stand rejected under 35 U.S.C. § 112 ¶ 2 as being allegedly incomplete on grounds of allegedly omitting essential elements.
- b. Claim 1 stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2003/0083041 (Kumar).
- c. Claims 2-3 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Kumar.
- d. Claim 4 stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2003/0083041 (Kumar).
- e. Claims 5-6 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Kumar.
- f. Claim 13 stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,987,987 (Vacanti).

g. Claims 14-15 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Vacanti.

h. Claim 16 stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Vacanti.

i. Claims 17-19 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Vacanti.

j. Claim 20 stands rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Vacanti.

k. Claims 21-25 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Vacanti.

VII. Argument

a. The Examiner Clearly Erred in Rejecting Claims 1, 4, and 13 under 35 U.S.C. § 112 ¶ 2

The Examiner rejected claims 1 and 4 on grounds that the claims recite "computing a size-based cost to access the web content" but do not recite "determining the size of the requested web content." As a purported basis for this rejection, the Examiner cited M.P.E.P. § 2172.01 and asserted that the omitted step was "essential" to the invention and therefore that the specification was non-enabling as not allowing for the invention to be implemented without that step. Appellant submits that this rejection is clearly improper.

The "determining" step is not an "essential" step, even though it is a step that can of course be carried out in an exemplary embodiment to implement the claimed invention.

The recited "computing a size-based cost to access the web content" is the pertinent step. As the specification teaches, that computing step can be implemented by determining the size of

the web content and applying a cost to the determined size so as to compute a size-based cost. But merely because those are example enabling details for implementing the computing step does not mean that those enabling details are themselves essential steps to define the invention.

Indeed, one faced with the language "computing a size-based cost to access the web content" in Appellant's claims would have little problem understanding what that step means and how to implement it. This is particularly so when the claim term is read in light of the specification, which makes clear by way of example what can be involved in implementing the computing step. Furthermore, it is of course possible that a machine could carry out the step of "computing a size-based cost to access the web content" after some other machine performs the determining step, or given some pre-existing knowledge of the size of the content, and thus without expressly "determining" the size of the content. Alternatively, the machine *could* determine the size of the web content and then carry out the computing step.

The requirement to claim "essential" matter in M.P.E.P. § 2172.01 clearly does not mean that an appellant needs to put all of the example enabling details into each claim. Rather, the claims serve to recite the invention, while the specification serves to provide those enabling details. By the same token, the mere disclosure in the specification of example implementation does not make that example implementation "essential" or mandatory to be claimed, particularly when what is in fact claimed is clear and understandable as is the case with claims 1 and 4.

M.P.E.P. § 2172.01 makes clear that matter is "essential" only if the specification describes that the matter is necessary to practice the invention. In the *In re Mayhew* case cited by M.P.E.P. § 2172.01, the court affirmed the rejection of a claim on grounds that the claim did not recite application of a cooling bath but the specification taught that the resulting product would be inferior if a cooling bath was not applied. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356

(CCPA 1976). There is no analogous situation here. Appellant's specification does not have any teaching that failure to determine a size of the content would somehow result in an inferior process. Furthermore, the *In re Mayhew* case additionally addressed another claim that recited specific aspects of the cooling process, and the court held that the claim did not need to recite those specific aspects but that it was sufficient that the claim recited the cooling process as a general matter. That is more like the present case, where there is no need for the claim to recite the "determining" function as an aspect of the recited "computing" function.

Moreover, although the Examiner cited to page 30, lines 15-21, of the specification as allegedly teaching that the "determining" function is essential to the invention, a review of that portion of the specification and the specification as a whole makes clear that the "determining" step is not essential but is rather merely an example implementation detail. In particular, the cited portion states:

In accordance with the exemplary embodiment, the intermediation system will compute a cost to access given web content based at least in part on the size of the web content, such as the number of bits, bytes, characters or other units of data that make up the web content. For instance, the intermediation system could determine the size of the web content and then multiply the size by a charging rate, which could vary based on user, time/day, content provider or other factors.

Without question, that disclosure makes clear that determining the size of the content is merely an example implementation detail, which *can* be claimed but does not need to be claimed. In addition, the specification states at pages 8-9 that the disclosure of the specification is provided as an example only and that variations from the example disclosed are possible, including the possibility of omitting described features:

It should be understood, however, that this and other arrangements described herein are set forth for purposes of example only. As such, those skilled in the art will appreciate that other arrangements and other elements (e.g., machines,

interfaces, functions, orders of functions, etc.) can be used instead, and some elements may be omitted altogether.

In the "Response to Arguments" section of the final office action, the Examiner expressed the view that the "determining" step has to be recited in claims 1 and 4 because claims 1 and 4 are method claims and are expected to provide step-by-step processes. But the mere fact that claims 1 and 4 are method claims does not mean that claims 1 and 4 need to recite every example implementation detail set described in the specification. Indeed, if the Examiner were correct about the missing feature being "essential" and needing to be claimed, one could argue that Appellant's entire detailed description (all 30 or so pages) would need to be recited expressly in the claims, since the specification serves to provide numerous example implementation details. Yet just as that result would be unnecessary and illogical, so to is it unnecessary for claims 1 and 4 to recite expressly the example implementation detail noted by the Examiner.

The Examiner additionally rejected claim 13 on largely the same basis, for omitting "detecting a hyperlink in web content being delivered to a client station" and "determining a size of the web content referenced by the hyperlink" when claim 13 recites "computing a size-based cost to access the web content." The points above apply here as well. Appellant's specification provides example implementation details for carrying out the actually recited claim features; yet that does not mean that the claim needs to recite those example details. Indeed, here again, the Examiner cited to a portion of the specification that states quite permissively what the intermediation system "could" do but provides no teaching that the features mentioned by the Examiner are somehow "essential" to the invention.

Ultimately, if the Examiner were correct about the missing features being "essential" and needing to be claimed, one could argue that Appellant's entire detailed description (all 30 or so

pages) would need to be recited expressly in the claims, since the specification serves to provide example implementation details. Yet just as that result would be unnecessary, so to is it unnecessary to recite expressly the example implementation details noted by the Examiner.

Claims 1, 4, and 13 are clear and fully enabled by the specification. There are no "essential" missing features. Therefore, Appellant submits that the Examiner clearly erred in rejecting claims 1, 4, and 13 under 35 U.S.C. § 112 ¶ 2 as allegedly omitting essential steps, and thus that the § 112 rejections of those claims should be reversed.

b. The Examiner Clearly Erred in Rejecting Claim 1 under 35 U.S.C. § 102(e)

The Examiner clearly erred in rejecting claim 1 as being allegedly anticipated by Kumar, because Kumar does not disclose (expressly or inherently) each and every element of claim 1. At a minimum, for instance, Kumar fails to teach carrying out the computing, engaging, and sending functions *during transmission of the web request within the communication path from the client station to the content server* as recited by claim 1.

At best, Kumar merely teaches a wireless communication device (client station) itself estimating a cost based on quantity of data to be communicated, and presenting the estimate to a user of the wireless communication device before proceeding with session initiation. Functions carried out at the wireless communication device, according to Kumar, cannot occur during transmission of the web request within the communication path from the client station to the content server, between the client station and the content server, as recited in claim 1. Further, considering the amended language of claim 1, the functions carried out at the wireless communication device, according to Kumar, cannot occur *between the client station and the content server* as in claim 1. Thus, Kumar clearly fails to anticipate claim 1.

In the "Response to Arguments" section of the final office action, the Examiner disputed this point. However, a close review shows the Examiner's position is incorrect.

The Examiner noted that Kumar is directed to a cost estimate for the communication session, determined based on quality of service level and quantity of information to be communicated, per Kumar's abstract. The Examiner then noted that Kumar discloses at paragraph 0037 that cost of service information 510 may be provided directly by the networks to a wireless communication device in real time. And the Examiner noted that Kumar teaches at Figure 6 and paragraphs 0045, 0047, and 0051 that the communication session is initiated when the cost estimate is presented to the user and accepted. In light of these pieces of disclosure, the Examiner argued that Kumar clear provides for the claim 1 limitations of "... during transmission of the web request within the communication path between the content server and the client station...", "computing...", "engaging...", and "...sending..."

A review of claim 1 and of Kumar's disclosure shows that this conclusion by the Examiner is clearly erroneous. Kumar is plainly directed to having the wireless device (i.e., the client) estimate the cost of a desired session *before the wireless device sends a request for the content, i.e., before the wireless device actually initiates the session*. It would be impossible in that scenario for the cost to be computed *during* transmission of the web request from the client to the content server, since the web request has not yet been transmitted at the time the cost is computed by the client. At a bare minimum, Kumar thus does not teach *computing* a size-based cost *during transmission of the web request within the communication path from a client station to a content server, between the client station and the content server*.

Appellant notes that Figure 6 and the accompanying description of Kumar provide for session initiation as a first step 602 of the process. However, it is plainly evident from a reading

of Kumar as a whole that the session is not actually initiated by the device until the device receives user approval of the estimated session cost. For instance, see paragraphs 0029 and 0045-0054, particularly the last sentence of paragraph 0048. The best Appellant can guess about the disclosure of step 602 in Kumar is that the step means that a user directs the device to initiate a particular session, which then triggers the process of the device performing the cost estimate before actually initiating the session. In any event, there is no disclosure in Kumar that a web request is in transit between the client and the content server when the cost estimate is performed, and so Kumar clearly does not anticipate claim 1.

The Examiner focused on Kumar's disclosure at paragraph 0037 of networks providing cost of service information to the wireless device "in real time" as somehow constituting a disclosure that a size-based cost is computed during transmission of the web request within the communication path from the client to the content server. However, that analysis by the Examiner is not correct. Although Kumar does not explain at paragraph 0037 what "real time" providing of cost of service information means, Kumar defines that concept at paragraphs 0020-0021, where Kumar teaches that networks may provide network capability information (including cost of service information) "in real-time to wireless communication device 102, for example over a broadcast channel accessible by wireless communication device 102." Yet *broadcasting* such information does not expressly or inherently involve sending the information *during transmission of a web request within the communication path from the client station to the content server*.

Kumar also teaches at paragraph 0037 that the wireless device may request cost of service information from the network and receive the cost of service information in response. However, again, Kumar does not teach that such a request/receive process occurs during transmission of a

web request within the communication path from the client station to the content server. Rather, it is clear from a reading of Kumar that the wireless device receives the cost of service information from the network in advance of the device even initiating the session, and so the device clearly has not yet sent a request for the content by the time the session cost is estimated.

Appellant pointed out the above errors to the Examiner in the response filed by Appellant on January 27, 2009. Yet in the final office action, the Examiner then repeated largely verbatim the anticipation rejections, without seeking to rebut the errors pointed out by Appellant.

For instance, the Examiner did not seek rebut the fact that Kumar is clearly directed to having the wireless device (i.e., the client) estimate the cost of a desired session *before the wireless device sends a request for the content, i.e., before the wireless device actually initiates the session*, and the fact that it would be impossible in that scenario for the cost to be computed *during* transmission of the web request from the client to the content server, since the web request has not yet been transmitted at the time the cost is computed by the client.

The Examiner asserted that "computing a size-based cost to access the web content" without "determining the size of the requested web content" is at best merely an estimate of the cost. But putting aside the fact that claim 1 does not preclude determining the size of requested web content, and thus without acquiescing in the Examiner's assertion, the Examiner's point does not justify the anticipation rejection. Even if the claim did recite "estimating" a size-based cost rather than "computing" a size-based cost, the fact remains that the claim recites the computing function occurring during transmission of the web request within the communication path from the client station to the content server, between the client station and the content server, and so Kumar's mere disclosure of the client station computing or estimating a cost cannot possibly amount to the claim feature.

The Examiner additionally noted that the claim 1 feature of "after receiving the user approval, sending the request along to the content server" means the device sends a request for the content before the device actually initiates the session. Yet putting aside the question of whether this point has merit (which Appellant does not address or concede), the point does not relate to the actual deficiency of Kumar, which is at a minimum that Kumar fails to teach the claim feature of *computing a size-based cost during transmission of the web request within the communication path from a client station to a content server, between the client station and the content server.*

Because Kumar fails to teach the invention recited by claim 1, Kumar does not anticipate claim 1. Therefore, the Examiner clearly erred in rejecting claim 1, and so the rejection of claim 1 should be reversed and claim 1 should be allowed.

**c. The Examiner Clearly Erred in Rejecting
Claims 2-3 under 35 U.S.C. § 102(e)**

Claims 2 and 3 depend from claim 1 and each stand rejected as being allegedly anticipated by Kumar. For the reasons discussed above, Kumar fails to anticipate claim 1. Since claims 2 and 3 each incorporate all of the features of claim 1, Kumar thus necessarily also fails to anticipate claims 2 and 3. Therefore, the Examiner clearly erred in rejecting claims 2 and 3, and so the rejections of claims 2 and 3 should be reversed and claims 2 and 3 should be allowed.

**d. The Examiner Clearly Erred in Rejecting
Claim 4 under 35 U.S.C. § 102(e)**

The Examiner clearly erred in rejecting independent claim 4 as being allegedly anticipated by Kumar, because Kumar does not disclose (expressly or inherently) each and every element of claim 4. At a minimum, for instance, Kumar fails to teach carrying out the

computing, engaging, and sending functions *during transmission of the web content within the communication path from the content server to the client station* as recited by claim 4.

At best, Kumar merely teaches a wireless communication device (client station) itself estimating a cost based on quantity of data to be communicated, and presenting the estimate to a user of the wireless communication device before proceeding with session initiation. Functions carried out at the wireless communication device, according to Kumar, cannot occur during transmission of the web content within the communication path from the content server to the client station, between the content server and the client station, as recited in claim 4.

Appellant submits that the arguments set forth above regarding claim 1 extend to apply with respect to claim 4. Because Kumar teaches that the wireless device (client) estimates session cost before even initiating the session, it is clear that the wireless device has not sent the content request by the time the wireless device estimates the session cost, and it is therefore clear that the cost estimate is not performed during transmission of the web content from the content server to the client device.

Because Kumar does not teach the combination of elements recited by claim 4, Kumar does not anticipate claim 4. Therefore, the Examiner clearly erred in rejecting claim 4, and so the rejection of claim 4 should be reversed and claim 4 should be allowed.

**e. The Examiner Clearly Erred in Rejecting
Claims 5-6 under 35 U.S.C. § 102(e)**

Claims 5 and 6 depend from claim 4 and each stand rejected as being allegedly anticipated by Kumar. For the reasons discussed above, Kumar fails to anticipate claim 4. Since claims 5 and 6 each incorporate all of the features of claim 4, Kumar thus necessarily also fails to

anticipate claims 5 and 6. Therefore, the Examiner clearly erred in rejecting claims 5 and 6, and so the rejections of claims 5 and 6 should be reversed and claims 5 and 6 should be allowed.

**f. The Examiner Clearly Erred in Rejecting
Claim 13 under 35 U.S.C. § 102(e)**

The Examiner clearly erred in rejecting independent claim 13 as being allegedly anticipated by Vacanti, because Vacanti does not disclose (expressly or inherently) each and every element of the claim. At a minimum, for instance, Vacanti does not disclose the combination of elements recited claim 13 including the function of *computing a size-based cost to access the web content and adding an indication of the size-based cost into the web content in conjunction with the hyperlink, such that the indication of the size-based cost will be presented to a user when the web content is presented to the user.*

As noted by the Examiner, Vacanti teaches embellishing a hyperlink with an indication of cost to access the referenced web content. However, Vacanti does not teach embellishing the hyperlink with a *size-based cost* to access the referenced web content. Therefore, Vacanti does not anticipate claim 13.

In the final office action, the Examiner expressed disagreement with this position, by noting that Vacanti further discloses at column 20, lines 51-55, that users pay in advance for quantity of access. However, it is clear from a reading of that section of Vacanti as a whole that the section has nothing to do with determining a size-based cost of given content. At best, that statement in Vacanti may relate to a limitation on the quantity of data being communicated. But it does not teach anything about determining a cost based on a given quantity of data (if that is what the Examiner meant), and more specifically it does not disclose the claim function of

computing a size-based cost to access the web content. Appellant's claims recite that function. The Vacanti reference does not teach that function.

In the "Response to Argument" section, the Examiner asserted that Vacanti's disclosure of a user paying in advance for "quantity of access", as well as Vacanti's disclosure of adding cost into web content being delivered to a user, amounts to Appellant's "computing a size-based cost to access the web content" function. However, that conclusion is incorrect. The cited Vacanti disclosure does not expressly teach computing a size-based cost to access the web content, and such a teaching does not follow necessarily from Vacanti's teachings and is therefore not inherent in Vacanti. It is entirely plausible within the teachings of Vacanti that content cost can be computed on a basis that has nothing to do with the size of the content requested. For instance, content cost can theoretically be computed based on a predefined cost associated with the content file (e.g., based on the usefulness of the content file), such as by reference to a lookup table that lists costs and URLs, as in Vacanti at Figure 13.

Furthermore, here again, the Examiner asserted that "computing a size-based cost to access the web content" without "determining the size of the requested web content" is at best merely an estimate of the cost. But putting aside the fact that claim 13 does not preclude determining the size of requested web content, the Examiner's point does not justify the anticipation rejection. Even if the claim did recite "estimating" a size-based cost rather than "computing" a size-based cost, the fact remains that the claim recites *computing a size-based cost to access the web content and adding an indication of the size-based cost into the web content in conjunction with the hyperlink, such that the indication of the size-based cost will be presented to a user when the web content is presented to the user*, and Vacanti simply does not disclose that feature.

Because Vacanti does not expressly or inherently teach the invention as recited in claim 13, Vacanti does not anticipate claim 13. Consequently, the Examiner clearly erred in rejecting claim 13, and so the rejection of claim 13 should be reversed and claim 13 should be allowed.

**g. The Examiner Clearly Erred in Rejecting
Claim 14-15 under 35 U.S.C. § 102(e)**

Claims 14 and 15 depend from claim 13 and each stand rejected as being allegedly anticipated by Vacanti. For the reasons discussed above, Vacanti does not anticipate claim 13. Since claims 14 and 15 each incorporate all of the features of claim 13, Vacanti thus necessarily also does not anticipate claims 14 and 15. Therefore, the Examiner clearly erred in rejecting claims 14 and 15, and so the rejections of claims 14 and 15 should be reversed and claims 14 and 15 should be allowed.

**h. The Examiner Clearly Erred in Rejecting
Claim 16 under 35 U.S.C. § 102(e)**

The Examiner clearly erred in rejecting claim 16 for largely the same reason that the Examiner erred in rejecting claim 13. Vacanti does not anticipate claim 16, at a minimum because Vacanti does not disclose *determining a cost of the referenced web content based at least in part on a size of the referenced web content, and adding into the web content an indication of the determined cost, such that the indication will be presented to a user when the web content is presented to the user* as recited in claim 16

Because Vacanti does not expressly or inherently teach the invention as recited in claim 16, Vacanti does not anticipate claim 16. Consequently, the Examiner clearly erred in rejecting claim 16, and so the rejection of claim 16 should be reversed and claim 16 should be allowed.

**i. The Examiner Clearly Erred in Rejecting
Claims 17-19 under 35 U.S.C. § 102(e)**

Claims 17-19 depend from claim 16 and each stand rejected as being allegedly anticipated by Vacanti. For the reasons discussed above, Vacanti does not anticipate claim 16. Since claims 17-19 each incorporate all of the features of claim 16, Vacanti thus necessarily also does not anticipate claims 17-19. Therefore, the Examiner clearly erred in rejecting claims 17-19, and so the rejections of claims 17-19 should be reversed and claims 17-19 should be allowed.

**j. The Examiner Clearly Erred in Rejecting
Claim 20 under 35 U.S.C. § 102(e)**

The Examiner clearly erred in rejecting claim 20 for largely the same reason that the Examiner erred in rejecting claim 13. Vacanti does not anticipate claim 20, at a minimum because Vacanti does not disclose *computing a size-cost to access the referenced web content, inserting into the web content an indication of the size-based cost and thereby establishing cost-embellished web content, and sending the cost-embellished web content along for receipt and presentation by a browser running on the client station* as recited in claim 20.

Because Vacanti does not expressly or inherently teach the invention as recited in claim 20, Vacanti does not anticipate claim 20. Consequently, the Examiner clearly erred in rejecting claim 20, and so the rejection of claim 20 should be reversed and claim 20 should be allowed.

**k. The Examiner Clearly Erred in Rejecting
Claims 21-25 under 35 U.S.C. § 102(e)**

Claims 21-25 depend from claim 20 and each stand rejected as being allegedly anticipated by Vacanti. For the reasons discussed above, Vacanti does not anticipate claim 20. Since claims 21-25 each incorporate all of the features of claim 20, Vacanti thus necessarily also

does not anticipate claims 21-25. Therefore, the Examiner clearly erred in rejecting claims 21-25, and so the rejections of claims 21-25 should be reversed and claims 21-25 should be allowed.

I. Conclusion

Appellant has demonstrated that the rejections of claims 1-6 and 13-25 are in error as a matter of law. Appellant therefore requests reversal of the rejections and allowance of the claims.

Respectfully submitted,

**MCDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: December 1, 2009

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CLAIMS APPENDIX

1. (Previously presented) In a communication system wherein a request for web content is transmitted over a communication path from a client station to a content server, a method comprising the following functions carried out during transmission of the web request within the communication path, between the client station and the content server:

computing a size-based cost to access the web content;

engaging in interstitial communication with the client station to receive user approval to pay the size-based cost; and

after receiving the user approval, sending the request along to the content server.

2. (Original) The method of claim 1, wherein computing the size-based cost to access the web content comprises:

multiplying a charging-rate by a size of the web content.

3. (Original) The method of claim 2, wherein computing the size-based cost to access the web content further comprises:

selecting the charging rate based at least in part on a factor selected from the group consisting of (i) a service level of a user requesting the web content and (ii) a time of day.

4. (Previously presented) In a communication system wherein web content is transmitted over a communication path from a content server to a client station, a method

comprising the following functions carried out during transmission of the web content within the communication path, between the content server and the client station:

computing a size-based cost to access the web content;

engaging in interstitial communication with the client station to receive user approval to pay the size-based cost; and

after receiving the user approval, sending the web content along to the client station.

5. (Original) The method of claim 4, wherein computing the size-based cost to access the web content comprises:

multiplying a charging-rate by a size of the web content.

6. (Original) The method of claim 5, wherein computing the size-based cost to access the web content further comprises:

selecting the charging rate based at least in part on a factor selected from the group consisting of (i) a service level of a user requesting the web content and (ii) a time of day.

7-12. (Cancelled)

13. (Original) In a communication system wherein web content is transmitted over a communication path from a content server to a client station, the web content defining a hyperlink to be presented by a browser running on the client station, the hyperlink pointing to referenced web content, a method comprising:

during transmission of the web content within the communication path, between the content server and the client station, (i) computing a size-based cost to access the web content and (ii) adding an indication of the size-based cost into the web content, in conjunction with the hyperlink, such that the indication will be presented to a user when the web content is presented to the user.

14. (Original) The method of claim 13, wherein the communication path extends from the content server, over a packet-switched network, and through an access channel to the client station, the method further comprising:

carrying out at least the adding function within the access channel.

15. (Original) The method of claim 13, further comprising:
engaging in interstitial communication with the user, to collect user-payment of the size-based cost for the referenced web content.

16. (Original) In a communication system wherein web content is transmitted over a communication path from a content server to a client station, a method comprising, during transmission of the web content within the communication path, the following functions:

receiving the web content;

detecting a hyperlink within the web content, wherein the hyperlink points to referenced web content;

determining a cost of the referenced web content based at least in part on a size of the referenced web content;

adding into the web content, in conjunction with the hyperlink, an indication of the determined cost; and

sending the web content, including the indication, along the access channel to the client station,

whereby the indication will be presented to a user when the web content is presented to the user, thereby giving the user an advanced notice of the cost of the referenced web content.

17. (Original) The method of claim 16, wherein the communication path comprises an access channel between the client station and a packet-switched network, the method comprising carrying out the functions within the access channel.

18. (Previously presented) The method of claim 16, wherein determining the size-based cost comprises multiplying a charging rate by the size of the web content.

19. (Original) The method of claim 16, wherein the web content is defined by a set of markup language, and wherein adding the indication of the size-based cost in conjunction with the hyperlink comprises adding into the set of markup language, adjacent to the hyperlink, display text indicative of the size-based cost.

20. (Original) An intermediation system disposed within a web communication path between a client station and a packet-switched network, the intermediation system comprising:

a network interface for receiving and sending communications on the HTTP communication path, wherein the network interface receives a communication that carries web content and the web content defines a hyperlink that points to referenced web content;

cost-computation logic for computing a size-based cost to access the referenced web content; and

cost-embellishment logic for inserting into the web content an indication of the size-based cost to access the referenced web content and for thereby establishing cost-embellished web content,

wherein the network interface sends the cost-embellished web content along the access channel for ultimate receipt and presentation of the cost-embellished web content by a browser running on the client station.

21. (Original) The intermediation system of claim 20, wherein the cost-computation logic and cost-embellishment logic are embodied in software executable by a processor.

22. (Original) The intermediation system of claim 20, wherein the communication path comprises an access channel between the client station and a packet-switched network, and wherein the intermediation system is disposed within the access channel.

23. (Original) The intermediation system of claim 22, wherein the client station is a mobile station, and the access channel comprises an air interface and a radio access network.

24. (Original) The intermediation system of claim 22, further comprising:
size data that specifies the size of the referenced web content,
wherein the cost-computation logic computes the size-based cost at least in part by
applying a charging-rate to the size.

25. (Original) The intermediation system of claim 22, further comprising:
exception data that indicates whether a user of the client station already has a right to
access the referenced web content,
wherein the cost-embellishment logic does not insert the indication of size-based cost if
the exception data specifies that the user of the client station already has a right to access the
referenced web content.

EVIDENCE APPENDIX

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RELATED PROCEEDINGS APPENDIX

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